

## **REMARKS/ARGUMENTS**

### **A. Amendment to the Claims**

Claims 1-4, 6, 9-12, 22, 23, 44-55 and 57-67 remain in the application. Claims 1, 6, 9-12, 22, 49, 50, 55, 57, 58, 59 and 60 are amended. Claims 5, 7, 8, 13-21, 24-43 and 56 are canceled. New Claims 68-75 are added.

Claim 1 is amended to correct antecedent basis to the set of keys, and to add a change tool as an element that had been inferentially claimed.

Claim 6 is amended to add back the limitation a second passage configured in the plug, which had been inadvertently deleted in claim amendments mailed November 15, 2006, wherein the double bracket placed at the end of line 10 was intended to have been placed at the end of line 9, as understood and acknowledged in the Examiner's summary of the interview dated February 1, 2007. Claim 6 is also amended to provide that the plug has at least one retainer cavity, to correct antecedent basis to the set of keys, to provide a change tool as element that had been inferentially claimed, to limit the change member to a change ball, and to improve the readability of the claim.

Claim 59 is amended to further provide that the at least one change ball returned to its first position places the lock in a reset configuration.

Claim 60 is amended to correct antecedent basis to the set of keys, and to add a change tool as an element that had been inferentially claimed.

Claims 9-12, 22, 49, 50, 55, 57, 58 are amended to add or correct antecedent bases, and to change claim dependency.

New claims 68-75 are added. Claim 68 is similar to Claim 1, where certain limitations to the following elements have been deleted as unnecessary to define the invention: the housing, the drivers, the keyway, the tumbler chambers, the change tool and the change tool slot. The change tool is defined as movable within the change tool slot between a first position that does not intersect the at least one retainer cavity, and a second position that intersects the at least one retainer cavity, as supported by para. [0164] and Figures 16A, 16B, 17A and 17B.

Applicants believe that no new matter has been added by way of the amendments to the specification or claims.

### B. Objection to the Disclosure

The objections raised by the Examiner in paragraphs [0170], [0192] and [0225] have been corrected by amendment.

### C. Objections in the Claims

The objections to the claims have been corrected by amendment. In claim 6, “a subset” has been replaced with “the set”.

The Examiner requests clarification of the operation and reconfiguration of the using the second key. Claim 6 provides that the change ball is movable from the first position to the second position. When the change ball is disposed in the first position, the lock is configured for operation by the first user key. However, in this embodiment, the second user key can cause the lock to be reconfigured to operate with the second user key by moving the change ball. Once reconfigured to operate with the second user key, operation with the second user key does not involve movement of the change ball, which is already in its second position. Consequently, the second user key both reconfigures and operates the lock when configured for operation with the first user key, and operates the lock when configured to operate with the second user key. This operation is described in paragraph [0137].

A similar objection is raised for Claim 59. Claim 59 provides that when the lock is in a reset configuration, insertion and rotation with the first key both operates the lock and reconfigures the lock for operation with the first user key. Consequently, in Claim 59, the first user key both reconfigures and operates the lock when configured in the rest configuration, and operates the lock when configured to operate with the first user key.

The objections to claims 7, 25, 27 and 28 are rendered moot by cancellation of these claims.

### D. Provisional Non-statutory Obviousness-type Double Patenting

The Examiner provisionally rejects claims 1-4, 6-15, 22-25, 27, 28 and 44-67 as unpatentable over claims 1-20 of co-pending application 11/178,627, and over claims 1-17, 21 and 22 of co-pending application 11/192,755.

Applicant traverses, noting that as no patents have yet been allowed or issued, whereby this rejection is premature. Notwithstanding, Applicant does not believe that the claims of the copending applications are obvious over the present application.

E. Rejection of Claims 6, 8-12, 22, 55, 58 and 59 under 35 USC 102(b) by Monahan (4,386,002).

Applicant requests reconsideration in view of the amendments made to the claims. In particular, Applicants have amended claim 6, from which the other claims depend, to provide a change ball that is neither disclosed nor suggested in Monahan. Reconsideration is respectfully requested.

F. Rejection of Claims 7, 13-15 and 24 under 35 USC 102(b) by Smith (4,741,188).

The rejection is rendered moot in view of the cancellation of all the claims.

G. Rejection of Claims 6, 8-12, 22, 23, 25, 27, 28, 55, 58 and 59 under 35 USC 103(a) as obvious over Smith (4,741,188) in view of Monahan (4,386,002).

Applicant traverses.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Either the reference must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the

claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985).

The Applicants believe that the Examiner has not met the initial burden of establishing a *prima facie* obviousness rejection. Specifically, the Examiner has not detailed any particular suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Monahan relates to a programmable lock that uses a uniquely-bitted programming tool to provide the appropriate configuration of master pins or disks in a series of blind holes to configure the lock for different user keys. Smith relates to a rekeyable lock that moves change wafers from the pin chamber into a blind hole to change use or master keying. Smith does not disclose or suggest providing the blind hole with an intersecting change slot or a change tool.

The Examiner considers that it would have been obvious to modify the lock of Smith to include a change tool and change tool slot to be used with the blind holes and change wafers of Smith. The Examiner suggests that the motivation for this combination is “the teaching of Monahan, the motivation being to simplify reprogramming of the lock”. Applicant contends that the Examiner’s explanation of motivation is not sufficient to support the *prima facie* rejection. All the references, including Applicant’s application, teach “simplifying reprogramming” of a lock. However, the Examiner has not pointed to any particular description in Monahan or Smith that would motivate a person of ordinary skill to incorporate the “change tool and change tool slot”, in the Examiner’s words, of Monahan.

Furthermore, neither Monahan nor Smith disclose using a change ball as a change member, as provided in Applicant’s amended claims, and therefore the alleged combination would not teach every element of Applicant’s claims.

Furthermore still, even if, for arguments sake, one were to use the alleged “change tool and change tool slot” of Monahan in the lock of Smith, the resulting lock would seem to look - essentially like Monahan, thereby obviating any need to consider a combination of the references.

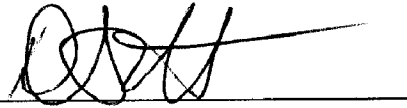
Consequently, this rejection should be withdrawn as failing to state a *prima facie* obviousness rejection.

Conclusion

Applicants believe a full and complete response to the Action has been made. Applicants request withdrawal of all objections and rejections, and allowance of all claims.

Respectfully submitted,

For: Rodrick A. Herdman

By 

Daniel F. Nesbitt

Attorney for Applicant

Registration No. 33,746

(513) 229-0383

Customer Number 26868

April 18, 2007